

In re application of Sato
Application No.: 10/786,168
Page 7 of 11

Atty. Dkt. No. 016907-1603

REMARKS

Claims 1-22 are pending in this application. Claims 15-22 have been indicated as withdrawn pursuant to a restriction requirement. Thus, claims 1-14 are currently pending and under consideration. In this response, Applicants have amended claims 1 and 8 to insert the transitional term "comprising" and to improve readability of the claims. The scope of the claims has not changed. In addition, Applicants have amended claims 5 and 12 to correct a typographical error. The status of all claims is shown in the Listing of Claims beginning at page 2 of this document.

Claim 1 provides a developing agent for black development, which is typically used in combination with a predetermined color developing agent. Claim 8 provides a developing agent to perform color development. Both the black and color developing agents of claims 1 and 8, respectively, include toner particles having either a black or chromatic coloring material, a polyester binder resin and two waxes, wherein the first wax has a softening point higher than the softening point of the corresponding resin and the second wax has a softening point lower than the softening point of the corresponding resin. The polyester resin of the black developing agent has an acidic value higher than that of the polyester resin of the color developing agent.

The acid value of the polyester resin used in the black developing agent is higher than that of the acid value of the polyester resin used in the color developing agent. This difference in the acid value eliminates the difference between the resistance values of the two developing agents, thereby eliminating a difference between their charging characteristics. This in turn leads to more uniform charging characteristics and consequently a more uniform image quality.

Rejection under 35 U.S.C. § 102(e) over Urabe

The rejection of Claim 1 under 35 U.S.C. § 102(e) as allegedly being anticipated by Urabe (U.S. Pub. App. No. 20040048182) is respectfully traversed.

DLMR_285400.1

In re application of Sato
Application No.: 10/786,168
Page 8 of 11

Atty. Dkt. No. 016907-1603

In order to anticipate a claim, a single prior art reference must provide each and every element set forth in the claim. *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); *see also*, MPEP §2131. The Examiner bears the initial burden of establishing a *prima facie* case of anticipation. Only once a *prima facie* case has been established does the burden shift to the applicant to rebut the *prima facie* case. *See, e.g., In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The present invention, as described for example in Claim 1, distinguishes over Urabe by requiring a developing agent which includes both a black developing agent and a color developing agent, each of which includes a polyester resin having a defined acidic value and two waxes, wherein one wax has a softening point higher than the corresponding resin, and the other wax has a softening point lower than the corresponding resin. Urabe does not describe such a developing agent.

In making the present rejection, the PTO has not specifically pointed to any disclosure in the Urabe references which discloses each of the required elements of claim 1 of the present invention. Urabe relates to a multi-layered toner particle having a toner core and a resin covering the surface of the toner core. Contrary to the PTO's assertion, Urabe does not describe the toner of claim 1. Specifically, Urabe does not disclose a developing agent which includes both toner particles having chromatic coloring material and toner particles having black coloring material. Furthermore, Urabe does not disclose a developing agent which includes two toners, wherein each of the toners includes two waxes; a first wax having a softening point higher than the softening point of the resin and a second wax having a softening point lower than the softening point of the resin.

Therefore, because Urabe does not disclose every element of claim 1, rejection is improper. Withdrawal of the outstanding rejection under §102 is respectfully requested.

DLMR_285400.1

In re application of Sato
Application No.: 10/786,168
Page 9 of 11

Atty. Dkt. No. 016907-1603

Rejection under 35 U.S.C. § 103 over Kido in view of Kurose and Yamashita

The rejection of claims 1-14 under 35 U.S.C. § 103(a) as allegedly being obvious over Kido et al. (U.S. Pat. No. 6,541,173), in view of Kurose et al. (U.S. Pat. No. 5,879,848) and Yamashita et al. (U.S. Pub. App. No. 2003/0165765) is respectfully traversed.

To establish a prima facie case of obviousness, three criteria must be met; (1) there must be some motivation or suggestion, either in the cited publications or in knowledge available to one skilled in the art, to modify or combine the cited publications; (2) there must be a reasonable expectation of success in combining the publications to achieve the claimed invention; and (3) the publications must teach or suggest all of the claim limitations. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2142.

As previously discussed, each developing agent comprises a polyester binder resin and two waxes, a first wax having a softening point greater than the softening point of the resin and a second wax having a softening point less than the softening point of the resin. Further, the polyester binder resin of the black developing agent has an acidic value greater than the acidic value of the color developing agent. The references cited by the PTO, taken alone or in combination, do not disclose such a developing agent.

The PTO suggests that Kido (the primary reference) teaches a developing agent having two release agents with two different softening points. Kido relates to a toner made up of two polyester resins and having two release agents. Kido, however, does not disclose that the developer includes two resins, each of which includes two waxes, wherein one wax has a softening point greater than that of the polyester resin and the second wax has a softening point less than that of the polyester resin, as required in the present invention. Additionally, Kido does not disclose a developing agent wherein the black developing agent has a greater acidic value than the color developing agent.

DLMR_285400.1

In re application of Sato
Application No.: 10/786,168
Page 10 of 11

Atty. Dkt. No. 016907-1603

Reliance on Kurose and Yamashita does not cure the deficiencies of the Kido reference. Kurose is directed to a developer having a full set of colors. Each color toner includes a color colorant and a first binder resin and the black toner includes a black colorant and a second binder resin. Kurose discloses that black and color toners ideally have a difference between the flow stating temperature and the softening point of no greater than 13°C. However, Kurose fails to disclose the relationship between the softening point of the two release agents and the polyester resin both the black toner and the color toner.

The PTO also suggests that Kurose teaches acid values in the binder resin, citing col. 4, lines 40-55. (See Office Action p. 3, lines 15-17). Contrary to the PTO's assertion, the disclosure in Kurose does not disclose that the black toner has a higher acid value than does the color toner. Instead, Kurose merely discloses that additional constituents can be added to adjust the acid value and improve the strength of the resin. (See Kurose, col. 4, lines 39-43). Additionally, the passage cited by the PTO does not disclose the relationship required by Claim 1 of the present invention, namely that the binder resin for the black coloring material has a higher acidic value than does the binder resin for the chromatic coloring material.

Similarly, reliance on Yamashita does not cure the deficiencies of the primary reference. Yamashita is directed to a carrier which includes core particles, wherein each particle can include a silicon coating thereon. The PTO relies upon Yamashita as disclosing the coating of the carrier with a silicon coating, a feature which is found in claims 6, 7, 13 and 14 of the present invention. However, while Yamashita does disclose a developing agent which includes a resin for a black coloring material having a higher acidic value than does the binder resin for a chromatic coloring material.

Thus, the rejection of claim 1-14 as being obvious over Kido in view of Kurose and Yamashita fails a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejection under §103 is respectfully requested.

DLMR_285400.1

In re application of Sato
Application No.: 10/786,168
Page 11 of 11

Atty. Dkt. No. 016907-1603

CONCLUSION

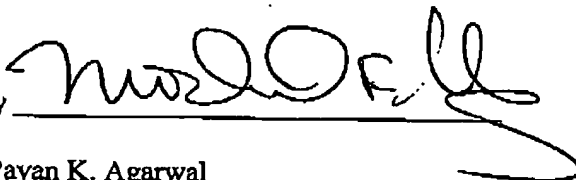
In view of the foregoing remarks, Applicant respectfully submits that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the telephone number listed below so that they may be resolved without the need for a written action.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16 1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date June 27, 2006

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6162
Facsimile: (202) 672-5399

By 

Pavan K. Agarwal
Registration No. 40,888
By Michael F. Hay
Registration No. 54,155
Attorney for Applicant

DLMR_285400.1